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| 10/800,591 | 03/15/2004 | Harold Weiss | Vanquish 2 | 1654 |
| 7590 Gregory P. Gadson, Esq. 19375 Amber Way Noblesville, IN 46060 | | | | |
| EXAMINER WILLIAMS, CLAYTON R | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,591

Applicant(s)

WEISS, HAROLD

Examiner

Clayton R. Williams

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 10-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond, US 6,697,462, in view of Sundsted (US 5,999,967: hereinafter Sundsted).

For claim 1, Raymond discloses:

A method of regulating electronic communications (Abstract), said method comprising the steps of:

- a) via a sender, purchasing a satisfaction bond to be coupled with a communication (col. 5, lines 52-55, at step 212 Party A posts bond), said bond being adapted to be forfeited if a recipient of the communication to which the bond is coupled rejects the communication (col. 5, line 67 – col. 6, lines 1-2, disclosure that if party B rejects email, then bond is forfeited);
- d) establishing said bond (col. 5, lines 52-53) comprising:

- e) via said sender, pledging or transferring a res in exchange for said bond (col. 5, lines 53-55, disclosure of credit card being used to purchase bond); and
- k) sending a message intended for a recipient accompanied by said bond (col. 5, lines 56-57, steps 214 and 216);
- m) subjecting said message to a filter when said bond is not determined to be legitimate or said message is not accompanied by a bond, said filter being adapted to accept or reject messages based upon predetermined criteria (col. 5, lines 48-52 and 55-60, disclosure that a message without a bond will be rejected by the email system); and
- n) not subjecting said message to a filter when said bond is determined to be legitimate (col. 5, lines 55-60, disclosure that a message with a proper bond will be accepted by the email system).

Raymond does not disclose the limitations:

- "f) generating a block of secure data, said secure data comprising:
 - g) a secure certificate containing at least sender identity indicia;
 - h) a digital signature;
 - i) a hashing code; and
 - j) a hash of the message for which said bond is to accompany; and
- l) prior to receipt of said message by the intended recipient, verifying the legitimacy of said bond via a third party

n) not subjecting said message to a filter when said bond is determined to be legitimate (note: Raymond does disclose this limitation; however Sundsted is being introduced to offer support in the alternative)."

However, Sundsted discloses:

"f) generating a block of secure data (col. 6, lines 54-57), said secure data comprising:

g) a secure certificate containing at least sender identity indicia (col. 7, lines 20-22, disclosure that sender and receiver addresses serve to bind electronic stamp to piece of email to prevent forging of identity);

h) a digital signature (col. 7, lines 28-29);

i) a hashing code (col. 7, lines 13-14); and

j) a hash of the message for which said bond is to accompany (col. 7, lines 12-13, Hash field 43); and

l) prior to receipt of said message by the intended recipient, verifying the legitimacy of said bond via a third party (col. 5, lines 53-55, disclosure that electronic stamp system features can be fully implemented in a third-party server between sender and receiver; col. 6, lines 24-25, disclosure that analysis module 23 validates the electronic stamp)

n) not subjecting said message to a filter when said bond is determined to be legitimate (col. 7, lines 62-67, disclosure that analysis module 23 will reject message if electronic stamp determined to be invalid)."

Raymond and Sundsted are analogous art because both are from the field of email filtering and verification.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Raymond with the teachings of Sundsted, an email system that implements digital certificate signing and verification, because this modification would ensure the integrity and authenticity of bonded messages.

For claim 2, Raymond discloses:

A system of regulating electronic communications (Abstract), said system comprising:

at least one message sender (col. 5, line 2, Party A);

at least one message recipient (col. 5, line 3, Party B);

a third party (col. 6, lines 64-65, disclosure of third-party clearing house);

a mechanism for allowing a sender to purchase a satisfaction bond to be coupled with a communication (col. 5, lines 52-55), said bond being adapted to be forfeited if a recipient of the communication to which the bond is coupled rejects the communication (col. 5, line 67 – col. 6, lines 1-2);

a bond generator adapted to establish said bond (col. 5, lines 52-53), said bond generator comprising:

a res exchanger adapted to allow said sender to pledge or transfer

a res in exchange for said bond (col. 5, lines 53-55);

a message transmitter adapted to send a message intended for a recipient accompanied by said bond (col. 5, lines 56-57);

a bond legitimacy verifier adapted to, prior to receipt of said message by the intended recipient, verifying the legitimacy of said bond via said third party criteria (col. 5, lines 48-52 and 55-60, disclosure that a message without a bond will be rejected by the email system);

a message filter adapted to filter said message when said bond is not determined to be legitimate or said message is not accompanied by a bond, said filter being adapted to accept or reject messages based upon predetermined criteria (col. 5, lines 55-60, disclosure that a message with a proper bond will be accepted by the email system).

Raymond does not explicitly disclose the limitations:

“a secure block generator adapted to generate a block of secure data, said secure data comprising:

a secure certificate containing at least sender identity indicia;

a digital signature;

a hashing code; and

a hash of the message for which said bond is to accompany;

a bond legitimacy verifier adapted to, prior to receipt of said message by the intended recipient, verifying the legitimacy of said bond via said third party (note: Raymond does disclose this limitation; however Sundsted is being introduced to offer support in the alternative);

and said message filter is adapted to forego filtering said message when said bond is determined to be legitimate.”

However, Sundsted discloses:

“a secure block generator adapted to generate a block of secure data (col. 6, lines 54-57), said secure data comprising:

- a secure certificate containing at least sender identity indicia (col. 7, lines 20-22);

- a digital signature (col. 7, lines 28-29);

- a hashing code (col. 7, lines 13-14); and

- a hash of the message for which said bond is to accompany (col. 7, lines 12-13);

a bond legitimacy verifier adapted to, prior to receipt of said message by the intended recipient, verifying the legitimacy of said bond via said third party (col. 5, lines 53-55; col. 6, lines 24-25); and said message filter is adapted to forego filtering said message when said bond is determined to be legitimate (col. 7, lines 62-67).”

Raymond and Sundsted are analogous art because both are from the field of email filtering and verification.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Raymond with the teachings of Sundsted, an email system that implements digital certificate signing and verification, because this modification would ensure the integrity and authenticity of bonded messages.

For claim 3, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

associating a unique number with each said bond which identifies the sender
(Sundsted, col. 7, lines 1-3, disclosure of serial number field 40).

For claim 4, the combination of Raymond and Sundsted discloses:

The method of Claim 1, wherein elements e) through j) are carried out by a
different entity from the sender (Sundsted, col. 5, lines 53-55).

For claim 5, the combination of Raymond and Sundsted discloses:

The method of Claim 1, wherein element l) is carried out by determining whether
the message is accompanied by a legitimate certificate (Sundsted, col. 6, lines 24-25).

For claim 6, the combination of Raymond and Sundsted discloses:

The method of Claim 1, wherein element l) is carried out by determining whether
the block of secure data has been altered (Sundsted, col. 6, lines 24-25).

For claim 7, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

upon receipt of a bonded message by said recipient, informing said recipient that

the message is accompanied by a satisfaction bond (Raymond, col. 5, lines 56-58); and

providing a recourse for the recipient if the recipient is unsatisfied with said message (Raymond, col. 5, line 67-col. 6, line 2, disclosure of recipient expressing displeasure by having sender's bond res sent to a designated entity; col. 6, lines 64-col. 7, line 5, disclosure that recipient can voice complaint on clearing-house).

For claim 10, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

when said recipient deems said message unsatisfactory, informing said third party that said message is unsatisfactory (Raymond, col. 6, line 67-col. 7, line 3, disclosure of recipients making report to clearing house).

For claim 11, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

when said recipient deems said message unsatisfactory, informing said third party that said message is unsatisfactory (Raymond, col. 6, line 67-col. 7, line 3, disclosure of recipients making report to clearing house); and
said third party keeping a tally of unsatisfactory messages sent by identified senders (Raymond, col. 5, line 29-33, tally of rejected messages sent by sender is updated).

For claim 12, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

when said recipient deems said message unsatisfactory, informing said third party that said message is unsatisfactory (Raymond, col. 6, line 67-col. 7, line 3, disclosure of recipients making report to clearing house);

said third party keeping a tally of unsatisfactory messages sent by identified senders (Raymond, col. 5, line 29-33, tally of rejected messages sent by sender is updated); and

said third party taking action against a sender when the number of unsatisfactory messages reaches a predetermined threshold (Raymond, col. 5, lines 4-9, disclosure that system will not forward emails for presentation to recipient where sender has history of sending emails that were later rejected).

For claim 13, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

said third party rejecting messages that contain a bond previously inserted into another message (Sundsted, col. 8, lines 1-8, disclosure that analysis module 23 checks whether electronic stamp is attached to original piece of email).

For claim 14, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

said third party rejecting messages that contain a bond that has been altered since being generated (Sundsted, col. 6, lines 24-25).

For claim 15, the combination of Raymond and Sundsted discloses:

The system of Claim 2, wherein said bond generator is further adapted to associate a unique number with each said bond which identifies the sender (Sundsted, col. 7, lines 1-3, disclosure of serial number field 40).

For claim 16, the combination of Raymond and Sundsted discloses:

The system of Claim 2, wherein said bond legitimacy verifier is further adapted to determine whether the block of secure data has been altered (Sundsted, col. 6, lines 24-25).

For claim 18, the combination of Raymond and Sundsted discloses:

The system of Claim 2, further comprising:

said recipient being further adapted to inform said third party of messages received that said recipient deems unsatisfactory (Raymond, col. 6, line 67-col. 7, line 3, disclosure of recipients making report to clearing house);

said third party being further adapted to keep a tally of unsatisfactory messages sent by identified senders (Raymond, col. 5, line 29-33, tally of rejected messages sent by sender is updated); and

said third party being further adapted to take action against a sender when the number of unsatisfactory messages reaches a predetermined threshold (Raymond, col. 5, lines 4-9, disclosure that system will not forward emails for presentation to recipient where sender has history of sending emails that were later rejected).

For claim 19, the combination of Raymond and Sundsted discloses:

The system of Claim 2, further comprising:

said third party being further adapted to reject messages that contain a bond previously inserted into another message (Sundsted, col. 8, lines 1-8, disclosure that analysis module 23 checks whether electronic stamp is attached to original piece of email).

For claim 20, the combination of Raymond and Sundsted discloses:

The system of Claim 2, further comprising:

said third party being further adapted to reject messages that contain a bond that has been altered since being generated (Sundsted, col. 6, lines 24-25).

4. Claims 8, 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond in view of Sundsted, as applied to claims 1 and 2, and further in view of Irlam et al. (US 6,650,890: hereinafter Irlam).

For claim 8, the combination of Raymond and Sundsted discloses:

The method of Claim 1, further comprising:

upon receipt of a bonded message by said recipient, informing said recipient that the message is accompanied by a satisfaction bond (Raymond, col. 5, lines 56-58); and

providing a recourse for the recipient if the recipient is unsatisfied with said message (Raymond, col. 5, line 67-col. 6, line 2; col. 6, lines 64-col. 7, line 3)

The combination of Raymond and Sundsted does not disclose the limitation "by referring the recipient to a hyperlinked Internet web site. Raymond and Sundsted are analogous art and the rationale for the combination can be found in the rejection for claim 1.

However, Irlam discloses a service for email that flags messages and notifies user via email that the message may be accessed on the message center web site (col. 5, lines 8-18). Raymond, Sundsted and Irlam are analogous art because all are from the field of third-party system email filtering.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Raymond and Sundsted with the teachings of Irlam, because this modification would allow a user the ability to lodge via a website complaints against those who send undesired emails.

For claim 9, the combination of Raymond, Sundsted discloses:

The method of Claim 1, further comprising:

- o) upon receipt of a bonded message by said recipient, informing said recipient that the message is accompanied by a satisfaction bond (Raymond, col. 5, lines 56-58);
- q) upon the recipient connecting to said web site, informing the seller of the bond that said message is unsatisfactory (Raymond, col. 5, line 67-col. 6, line 2, once recipient rejects acceptance of email, the bond is forfeited and res paid out to a designated party); and
- r) in response to element q), said seller penalizing said sender (Raymond, col. 6, lines 1-3, bond is forfeited by sender; Raymond, col. 5, line 29-33, as well tally of rejected messages sent by sender is updated).

The combination of Raymond and Sundsted does not disclose the limitation:

- p) providing a recourse for the recipient if the recipient is unsatisfied with said message, by referring the recipient to a hyperlinked Internet web site.

However, Irlam discloses a service for email that flags messages and notifies user via email that the message may be accessed on the message center web site (col. 5, lines 8-18). Raymond, Sundsted and Irlam are analogous art because all are from the field of third-party system email filtering.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Raymond and Sundsted with the teachings of Irlam, because this modification would allow a user the ability to lodge via a website complaints against those who send undesired emails.

For claim 17, the combination of Raymond and Sundsted discloses:

The system of Claim 2, further comprising:

said message transmitter is further adapted to, upon receipt of a bonded message by said recipient, inform said recipient that the message is accompanied by a satisfaction bond (Raymond, col. 5, lines 56-58), and provide a recourse for the recipient if the recipient is unsatisfied with said message (Raymond, col. 5, line 67-col. 6, line 2),

said web site being adapted to, upon the recipient connecting to it, inform the seller of the bond that said message is unsatisfactory (Raymond, col. 5, line 67-col. 6, line 2; and

said seller being further adapted to penalize said sender in response (Raymond, col. 6, lines 1-3; Raymond, col. 5, line 29-33).

The combination of Raymond and Sundsted does not disclose the limitation "by referring the recipient to a hyperlinked Internet web site. Raymond and Sundsted are analogous art and the rationale for the combination can be found in the rejection for claim 2.

However, Irlam discloses a service for email that flags messages and notifies user via email that the message may be accessed on the message center web site (col. 5, lines 8-18). Raymond, Sundsted and Irlam are analogous art because all are from the field of third-party system email filtering.

It would have been obvious to one skilled in the art at the time of the invention to modify the teachings of Raymond and Sundsted with the teachings of Irlam, because this modification would allow a user the ability to lodge via a website complaints against those who send undesired emails.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant Argument I: Sundsted and Raymond are nonanalogous art.

In response to applicant's argument that Sundsted is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Raymond and Sundsted address means by which an intended recipient of email messages may curtail/limit the receipt of email messages from undesirable senders. Particularly, Sundsted was introduced for purposes of teaching features which, to one of ordinary skill in the art at the time of the claimed invention would have been obvious to include, were not explicitly taught in the primary reference, Raymond. Principally, Examiner cited portions of Sundsted which teach the inclusion of secure/hashed data along with an email message. These features were cited for their ability to thwart forgeries of bonded messages. Regarding Applicant's contention that Sundsted does not apply "filtering" in the same vein as the claimed invention, Examiner

has clarified the rejection to also cite portions of Raymond which read on "filtering" of received messages.

Applicant Argument II: The combination of Raymond and Sundsted and Irlam are nonanalogous art.

In response to applicant's argument that Irlam is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the combination and Irlam address means by which an intended recipient of email messages may lodge a complaint or modify settings related to receipt of untoward messages. Particularly, Irlam was introduced for purposes of teaching a system wherein a user via a website may lodge complaints against an offending sender or configure options relating to email receipt and treatment of messages.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clayton R. Williams whose telephone number is 571-270-3801. The examiner can normally be reached on M-F (8 a.m. - 5 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nov. 12, 2008
CRW

Clayton R. Williams
Patent Examiner
Art Unit 2457

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Supervisory Patent Examiner, Art Unit 2457